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the folding boards shown by Hermach. The purported reason advanced by the Examiner is a non-sequitur. The Examiner asserts that:

“...it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Stemmler’s folding apparatus by having the longitudinal folds to the sheets, as suggested by Hermach, in order to improve the apparatus for associating and folding the respective sections of multi-sectioned bulky newspapers (col. 2, lines 1-4)”

Stemmler does not fold newspapers, however. Stemmler’s stated objective is to produce numerically correct partial stacks of interfolded sheet material (Stemmler, col. 1, lines 8-12). Stemmler’s interfolder is not suitable for folding newspapers. An interfolded newspaper would be extremely cumbersome to unfold for reading.

For that very reason one of ordinary skill in the newspaper arts would not have looked to the paper converting arts that utilize interfolders when seeking to improve apparatus for folding sections of newspapers. Newspaper sections are folded, not interfolded. Hermach does not show an apparatus similar to that of Stemmler. Rather, Hermach only shows a way of folding newspaper sections.

No valid reason has been advanced as to why one of ordinary skill in the paper converting arts would have looked to the newspaper folding art when seeking to improve on the production of numerically correct partial stacks of interfolded sheet material.

The Stemmler and Hermach references are not combinable to make a prima facie case of obviousness. One of ordinary skill would not have even attempted to interfold a newspaper. The selection of Stemmler and Hermach as references in this case clearly has been arrived at by impermissible reliance on the applicant’s own specification for guidance.

The recent U.S. Supreme Court decision in KSR International Co. v. Teleflex, Inc., No. 04-1350 (April 30, 2007) has reiterated the Graham factors to be considered in the determination of obviousness [Graham v. John Deere, 383 U.S. 1, 17-18; 148 U.S.P.Q. 459, 467 (1966)]. Among those factors is the resolution of the level of ordinary skill in the pertinent art. That has not been done in the present application. The level of ordinary skill in the paper converting arts has not been made of record, thus what would or would not have been obvious to one of ordinary skill in such art at the time the claimed invention was made

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cannot be ascertained with the necessary degree of particularity on the basis of the present record.

Considering the remaining Graham factors, applicant submits that the relevant art is paper converting machinery art. While interfolding machinery has been known for close to 100 years as evidenced by U.S. Patent No. 1,219,239 (1917) (of record), prior to the present invention no one in the paper converting art had combined web-folding dispensers, such as folding boards, with an interfolder and positioned the web-folding dispensers upstream from the folding rolls of the interfolder.

As to the differences between the prior art and the claims under consideration, the Examiner has conceded that the principal reference, Stemmler, which describes an interfolder apparatus, does not show the claimed performing dispensers.

As to secondary considerations, peer recognition by nomination for Idea 07 Achievement Award has been made of record previously. Thus, the Graham factors clearly militate against a finding of obviousness.

The attempted combination of the teachings of Stemmler and Hermach is clearly improper. The claimed invention must be considered as a whole. An invention composed of several mechanical elements is not proven obvious merely by demonstrating that each of these elements was known, independently, in the prior art. Here the Examiner has shown nothing more. The Examiner's own, unsupported allegations as to what would have been obvious at the time the invention was made cannot support an obviousness rejection.

It is not relevant in determining obviousness that some or all aspects of the claims may have been otherwise known in the art. Jones v. Hardy, 220 U.S.P.Q. 1021, 1025 (Fed. Cir. 1984)., Virtually all inventions are necessarily combinations of old elements. One cannot pick and choose among individual parts of assorted prior art references as a mosaic to create a facsimile of the claimed invention. Akzo N.V. v. United States ITC, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986).

It is also improper, as has been done in this instance, to use applicant's own specification as an instruction book on how to reconstruct the prior art. Panduit Corp. v. Dennison Mfg. Co., 1 U.S.P.Q.2d 1593, 1602 note 29. One of ordinary skill would not have had the applicant's own specification as a guide at the time this invention was made.

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To properly combine the references, there must be some teaching, suggestion or inference in the references themselves that would have led one of ordinary skill in the relevant art to combine the appropriate teachings. There are none here.

Here neither Stemmler nor Hermach provide the requisite motivation to pick, choose and assemble the claimed apparatus. Stemmler is concerned about producing numerically correct partial stacks from individual sheets interfolded in conventional manner. To do so, Stemmler focuses the attention of one of ordinary skill downstream from the folding rolls to which webs W1 and W2 are fed conventionally. Webs W1 and W2 are not preformed in any way. Hermach shows an entirely different apparatus. Hermach seeks to expedite the folding and collation of newspaper pages and sections, and has devised an apparatus to do so. Hermach, however, does not and cannot interfold newspaper pages. That would have resulted in a newspaper product totally unacceptable to the reading public.

Neither Stemmler nor Hermach address the problem (compact packaging) addressed and solved by the applicant. Here mechanical elements have been combined to achieve a new and unique functionality for an interfolder apparatus.

Regarding claim 13, the Examiner merely states that Stemmler's sheets of material include a plurality of spaced-apart, transversely extending perforation lines. That is not enough to support a rejection, especially in view of the Examiner's admission that the sheets disclosed by Stemmler lack the longitudinal fold line as well as the fold. The patentability of each claim must be evaluated in its entirety. That has not been done in this instance.

The rejection of claims 14 and 15 also is not supported by the record. The mere fact that Stemmler discloses use of knife rolls or perforations in his apparatus does not vitiate the patentability of these particular claims, especially in view of the Examiner's acknowledged omission. The apparatus of Stemmler is different, and the sheets to be processed are different as well.

Regarding claim 16, as recognized by the Examiner, Stemmler does not teach the longitudinal fold line, nor the fold. Stemmler also does not teach folding boards as the preforming dispensers. Contrary to the Examiner's unsupported assertions that Hermach discloses a similar apparatus, the fact remains that Hermach does not. Stemmler teaches an

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interfolder apparatus whereas Hermach teaches a rotary newspaper press and folder. The problems that Stemmler seeks to solve (numerically correct partial stacks of interfolded material) are very different from the problems that Hermach seeks to solve (increased newspaper folding speed), and the apparatus utilized to solve these problems are necessarily different. The Examiner's assertion that the "Hermach discloses a similar apparatus" has no basis in fact.

The new rejection of claim 12 under 35 U.S.C. 103(a) as unpatentable over Stemmler in view of Hermach and DuFresne is likewise traversed. The Examiner agrees that neither Stemmler nor Hermach show the claimed double "c"-shaped fold. Neither does DuFresne. The double "c"-shaped fold is illustrated in applicant's FIGURE 3(a) at 118. Nothing of the kind is shown by Stemmler, Hermach or DuFresne. Only zig-zag folds are shown by DuFresne and Stemmler. See, for example, FIG. 3 of DuFresne and FIGS. 6 & 7 of Stemmler. Withdrawal of this rejection is requested.

The foregoing discussion distinguishes fully the present apparatus claims over the applied references. Early passing of this application to issue is solicited.

Respectfully submitted,


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By 
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